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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,300	07/24/2000	Paul L. Hickman	HSC1P002.US01	7235
45965	7590	05/28/2010		
TIPS GROUP c/o Intellevate LLC P. O. BOX 52050 Minneapolis, MN 55402			EXAMINER STORK, KYLE R	
			ART UNIT 2178	PAPER NUMBER
			MAIL DATE 05/28/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/625,300

**Applicant(s)**

HICKMAN ET AL.

**Examiner**

KYLE R. STORK

**Art Unit**

2178

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5,6,10-20,31,32 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,10-20,31,32 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/C.3)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This non-final office action is in response to the election filed 12 March 2010.
2. Claims 1, 5-6, 10-20, 31-32, and 36 are pending. Claims 1, 31-32, and 36 are independent claims.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
4. Claims 1, 5-6 13-15, 20, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Takano et al. (US 6434580, filed 23 October 1998, hereafter Takano).

As per independent claim 1, Takano discloses an electronic document filing system comprising:

- a web server coupled to a WAN (Figure 15, item 300: Here, the server is a web server)
- a receiving agency server separate from the web server and coupled to the WAN, such that it is capable of communication with the web server (Figure 15, item 1000: Here, the Patent Office is the receiving agency)
- a client machine separate from the web server and said receiving agency server and coupled to the WAN for communication with the web server, such that the web server serves as an interface to the receiving agency server, the client machine providing information to the web

server forming at least a part of an electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves an interface to the receiving agency computer, the electronic document filed for further processing by a receiving agency associated with the receiving agency server in accordance with a procedure for which the receiving agency is in some manner responsible (Figure 15; column 6, lines 5-15 and 44-59)

wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine (Figure 15)

As per dependent claims 5 and 6, Takano discloses wherein the network includes a TCP/IP protocol network, including the Internet (column 5, lines 45-51).

As per dependent claim 13, Takano discloses wherein the portion of the electronic automatically provided in response to a selection originating from the client machine includes one of a blank form and a partially filled-in form based upon information stored on the server (Figure 3).

As per dependent claims 14 and 15, Takano discloses an application machine coupled to the WAN and communicating with the web server (Figure 15).

As per dependent claim 20, the applicant discloses the limitations substantially similar to those in claim 13. Claim 20 is similarly rejected.

As per claim 36, the applicant discloses the communication system substantially similar to the filing system of claim 1. Claim 36 is similarly rejected.

5. Claims 10-11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano and further in view of Blackwell, Jr. et al. (US 5857191, filed 8 July 1996, hereafter Blackwell).

As per dependent claim 10, Takano discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Takano fails to specifically disclose encrypting communications over a network. However, Blackwell discloses encrypting communications over a network (columns 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Takano, since it would have provided secure communications over a network.

As per dependent claim 11, Takano discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Takano fails to specifically disclose wherein communications between the client machine and the web server are subject to authentication. However, Blackwell discloses authentication (column 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Takano, since it would have provided secure communications over a network.

As per dependent claims 16-17, the applicant discloses the limitations substantially similar to those in claims 10-11, respectively. Claims 16-17 are similarly rejected.

As per dependent claims 18-19, the applicant discloses the limitations substantially similar to those in claims 10-11, respectively. Claims 18-19 are similarly rejected.

6. Claims 12 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano and further in view of Daleen et al. (US 6493722, filed 13 April 1999, hereafter Daleen).

As per dependent claim 12, Takano discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Takano fails to disclose an integrated billing system including within an electronic filing system wherein a server transacts a financial transaction with the receiving agency on behalf of a client machine. However, Daleen integrates a billing system including an electronic filing system wherein a server transacts a financial transaction with the receiving agency on behalf of a client machine (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Takano, since it would have allowed a client to have his/her fees paid to a receiving agency.

As per claims 31-32, the applicant discloses the limitations substantially similar to those disclosed by the combination of claims 1 and 12. Claims 31-32 are similarly rejected.

### ***Response to Arguments***

7. Applicant's arguments filed 30 November 2009 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE R. STORK whose telephone number is (571)272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle R Stork/  
Primary Examiner, Art Unit 2178